

REMARKS

In the specification, the last paragraph on page 3 (of the published WO 01/21679) has been amended to eliminate a typographical error.

Claims 1-8 are pending in the present application. Applicants have amended claims 1-3 and 5 to more clearly define the present invention. Support for the amendment to claim 1 is found in the WO 01/21679 specification at page 2, third and fourth full paragraphs, and at page 4, first paragraph. Support for the amendment to claim 2 appears at page 4, second paragraph. Support for the amendment to claim 3 appears at page 4, first paragraph. Support for the amendment to claim 5 is found in the WO 01/21679 specification in the paragraph bridging pages 5 and 6. Accordingly, no new matter has been added.

Claim 7 has been cancelled.

Applicants have added new claims 9-15, support for which appears in the WO 01/21679 specification as follows:

Claim 9: Page 6, second full paragraph

Claim 10: Page 4, last paragraph

Claims 11-13: Page 5, first paragraph

Claims 14-15: Page 7, second and third full paragraphs

Accordingly, no new matter has been added. Applicants believe that no fee is due for new claims 9-15, as the total claims do not exceed 20 and the independent claims do not exceed three. If, however, Applicants are mistaken, additional claims fees may be charged to the undersigned's Deposit Account No. 16-2500.

1. The Rejection under 35 U.S.C. § 112, second paragraph

Claims 5 and 7 stand rejected as indefinite under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The amendment of claim 5 obviates this rejection as to claim 5. Claim 7 has been cancelled in favor of new claim 12. Applicants respectfully request that the rejection be withdrawn.

2. The Rejection of Claim 7 under 35 U.S.C. § 101

Claim 7 stands rejected under 35 U.S.C. § 101 because it is an improper use claim. Claim 7 has been cancelled in favor of claim 12. Applicants respectfully request that the rejection be withdrawn.

3. The Rejection of Claims 1-4, 6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over McCaleb

Claims 1-4, 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCaleb et al. (U.S. Patent No. 3,280,074). Applicants have obviated this ground for rejection

by amending claim 1. As so amended, claim 1 defines a curable composition wherein the adduct (element b) is always present.

McCaleb does not teach or suggest a curable composition comprising the adduct of Applicants' amended claim 1. Moreover, there is no motivation to modify McCaleb to produce the presently claimed curable composition comprising the adduct. According to MPEP 2143.01 and 2145, a reference cannot render the presently claimed invention obvious if there is no motivation or suggestion in the reference itself or in the knowledge of one skilled in the art to modify the prior art reference to be that of the claimed invention. Therefore, Applicants respectfully request that this ground for rejection be withdrawn.

4. The Rejection of Claims 1-4, 6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over McCaleb in view of Floyd

Claims 1-4, 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCaleb in view of Floyd (U.S. Patent No. 4,195,152). Applicants respectfully traverse the rejection.

The Examiner relies on a single example within Floyd of a structurally different adduct to assert that Applicants' class of curable resins and adducts would be obvious. Applicants submit that this single and divergent example in Floyd does not overcome the deficiencies of McCaleb.

Furthermore, Floyd teaches away from McCaleb and the presently claimed invention. Floyd acknowledges McCaleb in col. 1, lines 62-68 and goes on to distinguish itself from McCaleb through comparative Example 11 (col. 12, lines 35-65). Therein, Floyd indicates that the monotertiary-diprimary triamine of McCaleb is inferior to the N-alkylpolyamine of Floyd.

Applicants respectfully submit that one of skill in the art would not be motivated by Floyd to create an adduct of a monotertiary-diprimary triamine, since Floyd, in Example 11, discloses the inadequacy of the monotertiary-diprimary triamine of McCaleb. Thus, Applicants respectfully submit that Floyd teaches away from McCaleb and as such cannot be properly combined with McCaleb to render the presently claimed invention obvious. It is well known that it is improper to combine references where the references teach away from their combination. See MPEP § 2145. Applicants respectfully request that this ground for rejection be withdrawn.

CONCLUSION

Applicants believe that the present application is now in condition for allowance.
Favorable consideration of the application as amended is respectfully requested.

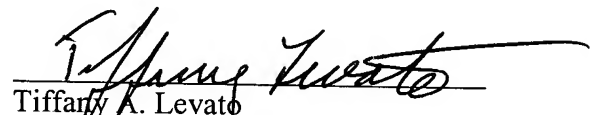
The Commissioner is authorized to charge any fee due, or credit any overcharge as a result of this Amendment and Response to Deposit Account No. 16-2500.

Respectfully submitted,

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By


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